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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,937	04/05/2002	Katsutoshi Nagi	SPO-0210	1232

9629 7590 05/18/2004
MORGAN LEWIS & BOCKIUS LLP
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WASHINGTON, DC 20004

EXAMINER

TRAIL, ALLYSON NEEL

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,937

Applicant(s)

NAGI ET AL.

Examiner

Allyson N Trail

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6, 8, 9 and 11 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 7, 10, and 12-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed December 10, 2003.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 4, 6, 8, and 11 rejected under 35 U.S.C. 102(e) as being anticipated by Kodukula et al (6,195,053).

Kodukula et al teaches the following in regards to claims 1, 6, and 8:

"In a first aspect of the present invention, a symbology reader has an optical reading assembly received in a reading assembly housing and an antenna shaped to conform to at least a portion of the reading assembly housing and in contact therewith." (Col. 1, lines 45-49).

"In yet a further aspect of the present invention, an antenna includes a conductive member having a shape at least partially conforming to a shape of a reading assembly housing in an imager." (Col. 1, lines 59-62).

"Antennas may serve to increase the reception and transmission of electromagnetic radiation. For example, antennas may be utilized to receive radio waves, such as in a typical radio transmittal device or radio frequency tag identification reader." (Col. 3, lines 10-14).

"The operating frequency will preferably be selected to avoid any permitting requirements, such as those set out by the U.S. Federal Communications Commission ("FCC"). One skilled in the art will also note that the RFID tag reading range is typically shorter than the symbol reading range of an optical reader. Therefore, the symbol reading range can be adjusted to match the RF tag reading range, such that RFID tags 606 (FIG. 6) and machine-readable symbols 604 (FIG. 6) can be acquired in a single operation without repositioning the reader 600 relative to the item carrying the data carriers. The antenna 626 should be positioned so that it does not interfere with the other components of the reader 600. The reading assembly housing can shield various components, such as the optical scanning components, from electromagnetic interference by the antenna 626." (Col. 5, lines 41-56).

Kodukula et al teaches the following in regards to claims 4 and 11:

"In FIG. 3B, the antenna 120 is a substantially planer member, that forms a top of an enclosure. Thus, the antenna 120 forms a portion of the reading assembly housing 111." (Col. 4, lines 22-24).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kodukula et al (6,195,053) in view of GABOU et al (2002/0068589).

Kodukula et al's teachings are discussed above. Kodukula et al fails to specifically teach a filter, which electrically connects the antenna to other electric circuits in the communication device.

GABOU et al teaches the following in regards to claims 2 and 9.

"The transmission circuit 15 is connected to the antenna 8 via a transmit filter 16 assigned to removing signal components other than those which are part of the transmit channel via which the terminal communicates with the network 2." (Page 2, paragraph 0023).

In view of GABOU et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a filter to electrically connect the antenna to other electric circuits in the communication device. Using a filter between electrical components is a configuration that is common in the art. The filter is used to ensure that only selected frequencies or signals are transmitted to the components by the antenna. One would be motivated to include a filter in order to allow the communication device to communicate at desired frequencies.

Allowable Subject Matter

6. Claims 3, 5, 7, 10, and 12-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent including all of the limitations of the base claim and any intervening claims.

The following is an examiner's for allowance: Although Kodukula et al in combination with GABOU et al teach a communication device that supplies electric power to a communication partner and communicates therewith by electromagnetic induction on a non-contact bases and also teaches many other features of the claimed invention, the above identified prior art of record, taken alone, or in combination with any other prior art, fails to teach or fairly suggest the specific features of claims 3, 5, 7, 10, and 12-15 of the present claimed invention. One feature not taught in prior art includes, the filter used the communication device having a frequency response that is identical with a frequency response of the portion of the second shielding member that faces the front face of the antenna. Another feature not taught by prior art is the first shielding member used in the communication device having a recess formed therein so as to sink inward also having the antenna being arranged in the recess, and further having the second shielding member being arranged so as to cover an opening of the recess. Additionally, in regards to the first shielding member, prior art fails to teach the member having a double structure by being composed of an inner layer made of a material that absorbs radio waves and an outer layer made of a material that reflects radio waves. Lastly, prior art fails to teach the second shielding member having four

quadrilateral openings formed therein in a grid-like arrangement. Moreover, one of ordinary skill in the art would not have been motivated to come to the claimed invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Muller et al (5,315,096), Tsukuda (5,438,690).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [allyson.trail@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record

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includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.



Allyson N. Trail
Patent Examiner
Art Unit 2876
May 3, 2004

THIEN M. LE
PRIMARY EXAMINER
